



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/672,556

09/25/2003

Dennis M. DiVenuta

9392-2

8847

20792 7590 02/05/2008  
MYERS BIGEL SIBLEY & SAJOVEC  
PO BOX 37428  
RALEIGH, NC 27627

EXAMINER

GAUTHIER, GERALD

ART UNIT

PAPER NUMBER

2614

MAIL DATE

DELIVERY MODE

02/05/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/672,556	Applicant(s) DIVENUTA ET AL.	
	Examiner Gerald Gauthier	Art Unit 2614	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-86 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-49, 51-64, 66-78 and 80-86 is/are rejected.
- 7) ☒ Claim(s) 10, 50, 65 and 79 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/10/06</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. **Claims 20-39** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. **Claim 20** is a single step claim therefore fails to comply with the enablement requirement.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1-86** are rejected under 35 U.S.C. 102(e) as being anticipated by Hill, SR. et al. (US 2006/0149587 A1).

Art Unit: 2614

Regarding **claims 1, 20, 40, 60 and 74**, Hill discloses a method for processing prescriptions (paragraph 0001) comprising:

answering a telephone call from a caller (paragraph 0019);

accepting identification of a pharmaceutical prescription from the caller (paragraph 0019);

querying at least one database using predefined criteria based on the identification of a pharmaceutical prescription to identify a targeted message; and playing the targeted message to the caller (paragraph 0021).

Regarding **claims 2, 21, 41, 61 and 75**, Hill discloses a method wherein the playing is followed by executing a refill call flow for the pharmaceutical prescription (paragraph 0022).

Regarding **claims 3, 22, 42, 62 and 76**, Hill discloses a method wherein the querying comprises querying at least one database using the predefined criteria based on the identification of a pharmaceutical prescription to identify a series of targeted messages (paragraph 0023); and

wherein the playing comprises playing a succeeding one of the series of targeted messages to the caller in response to receipt of a caller response to a preceding one of the series of targeted messages (paragraph 0023).

Art Unit: 2614

Regarding **claims 4, 23, 43, 63 and 77**, Hill discloses a method further comprising: receiving a caller response to the targeted message (paragraph 0019).

Regarding **claims 5, 24, 44, 64 and 78**, Hill discloses a method further comprising logging the caller response (paragraph 0019).

Regarding **claims 6, 25, 45 and 65**, Hill discloses a method further comprising instructing the pharmacy to perform an action in response to the caller response to the targeted message (paragraph 0020).

Regarding **claims 7, 26, 46, 66 and 80**, Hill discloses a method wherein the predefined criteria based on the identification of a pharmaceutical prescription comprise age of a patient who is using the pharmaceutical prescription, gender of the patient, medication of the pharmaceutical prescription, last fill date of the pharmaceutical prescription, days supply on last fill of the pharmaceutical prescription, original fill date of the pharmaceutical prescription, disease state of the patient, physician of the patient and/or other promotions in effect (paragraph 0023).

Regarding **claims 8, 27, 47, 67 and 81**, Hill discloses a method wherein the predefined criteria based on the identification of a pharmaceutical prescription do not include a personal identification of a patient who is using the pharmaceutical prescription (paragraph 0024).

Art Unit: 2614

Regarding **claims 9, 28, 48, 68 and 82**, Hill discloses a method wherein the predefined criteria based on the identification of a pharmaceutical prescription comprise age of the patient, gender of the patient, medication of the pharmaceutical prescription, last fill date of the pharmaceutical prescription, days supply on last fill of the pharmaceutical prescription, original fill date of the pharmaceutical prescription, disease state of the patient, physician of the patient and/or other promotions in effect, but do not include a personal identification of a patient who is using the pharmaceutical prescription (paragraph 0025).

Regarding **claims 11, 29, 49, 69 and 83**, Hill discloses a method wherein the targeted message comprises an educational message concerning the pharmaceutical prescription, a message that indicates alternative medications that may be substituted for the pharmaceutical prescription, a message that identifies other items that may be desired and/or a message that solicits participation in a study related to the pharmaceutical prescription (paragraph 0023).

Regarding **claims 12, 31, 51, 70 and 84**, Hill discloses a method wherein the querying comprises querying at least one database using the predefined criteria based on the identification of the pharmaceutical prescription to identify an educational targeted message concerning the pharmaceutical prescription (paragraph 0019).

Art Unit: 2614

Regarding **claims 13, 32, 52, 72 and 85**, Hill discloses a method wherein the querying comprises: querying at least one database using predefined criteria of last fill date and days supply on last fill date based on the identification of a pharmaceutical prescription (paragraph 0023); and

identifying an educational targeted message that reminds the caller how to use the pharmaceutical prescription if the last fill date is less than a first threshold and the days supply on last fill date is greater than a second threshold (paragraph 0023).

Regarding **claims 14, 33, 53, 73 and 86**, Hill discloses a method wherein the querying comprises: querying at least one database using predefined criteria of last fill date and days supply on last fill date based on the identification of a pharmaceutical prescription (paragraph 0025); and

identifying a targeted message that indicates alternative medications that may be substituted for the pharmaceutical prescription if the last fill date is less than a first threshold and the days supply on last fill date exceeds a second threshold (paragraph 0025).

Regarding **claims 15, 34 and 54**, Hill discloses a method wherein the querying comprises: querying at least one database using predefined criteria of age, gender, last fill date and days supply on last fill date based on the identification of a pharmaceutical prescription (paragraph 0019); and

identifying a targeted message that indicates other items that may be desired if the gender is female, the age exceeds a first threshold, last fill date is less than a second threshold and days supply on last fill date exceed a third threshold (paragraph 0019).

Regarding **claims 16, 35 and 55**, Hill discloses a method wherein the querying comprises: querying at least one database using a predefined criterion of age of a patient who is using the pharmaceutical prescription based on the identification of a pharmaceutical prescription (paragraph 0023); and

identifying a targeted message that that solicits participation of the patient in a study related to the pharmaceutical prescription if the age of the patient qualifies the patient to participate in the study related to the pharmaceutical prescription (paragraph 0023).

Regarding **claims 17, 36 and 56**, Hill discloses a method further comprising: providing additional targeted messages to allow the patient to participate in the 10 study if the patient agrees to participate (paragraph 0026).

Regarding **claims 18, 37 and 57**, Hill discloses a method wherein the querying comprises: querying at least one pharmacy dispensing system database using the identification of the pharmaceutical prescription to identify the predetermined criteria (paragraph 0027); and

Art Unit: 2614

querying at least one message database using the predetermined criteria to identify a targeted message (paragraph 0027).

Regarding **claims 19, 38, 39, 58 and 59**, Hill discloses a method wherein the identification of a pharmaceutical prescription is an Rx number (paragraph 0023).

### ***Allowable Subject Matter***

5. **Claims 10, 50, 65 and 79** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (571) 272-7539. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2614

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gerald Gauthier/  
Primary Examiner  
Art Unit 2614

/GG/  
January 27, 2008